REMARKS

Claims 1-70 are pending in the application.

Claims 1-70 have been rejected.

Claims 1, 9, 11-15, 23, 26, 28, 29, 37, 40, 42, 43 and 57 have been amended.

I. REJECTIONS UNDER 35 U.S.C. § 103

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gai (U.S. Patent No. 6,697,360) in view of O'Toole (U.S. Patent No. 6,345,294).

Claims 2-6, 15-20, 30-34, 43-48 and 57-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gai (U.S. Patent No. 6,697,360) in view of O'Toole (U.S. Patent No. 6,345,294).

Claims 7-14, 21-29, 35-42, 49-56 and 63-70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gai (U.S. Patent No. 6,697,360) in view of O'Toole (U.S. Patent No. 6,345,294) and further in view of Ekstrom (U.S. Patent No. 5,968,126).

The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Independent Claims 1, 15, 29, 43 and 57:

To further prosecution, independent Claims 1, 15, 29, 43 and 57 have been amended to recite: wherein at least a portion of the configuration information is detected by passively listening to control traffic and at least a portion of the configuration information is detected by direct communication with another network device.

The portions of Gai cited by the Office Action describe that a DHCP server and layer 3 switches are modified to handle enhanced DHCP messages communicated between the DHCP server and switches. Through these unique DHCP messages, one or more IP addresses and routing protocols may be received at the switches. Based on this received information, the switches may be

configured with "its IP subnets, IP addresses and routing protocols." However, Gai does not disclose or teach obtaining configuration information by passively listening to control traffic.

The portion of O'Toole cited by the Office Action describes an end device (e.g. appliance) connected to a network which runs a boot algorithm. The boot algorithm functions "to learn enough about the IP environment in which the appliance is installed to obtain a connection with an appliance registry 28 in order to download additional configuration information" from the appliance registry 28. But, the cited portion of O'Toole does not explain or identify what information is "learned" about the IP environment or describe any methods to obtain such information. Notably though, Col. 6, lines 36-49, describe that the appliance 28 may "broadcast a request and see if there are responses" - such as a boot or DHCP request to a boot server or DHCP server. Thus, to obtain configuration information, the appliance transmits messages, and in response to those messages, may receive configuration information. Therefore, it does not appear that O'Toole discloses or teaches obtaining configuration information by passively listening to control traffic.

As a result, Applicant submits the cited portions in the proposed combination of Gai and O'Toole fail to disclose, teach or suggest each and every element of the claimed invention.[1]

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 1-70.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

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[1] In addition, Ekstrom does not appear to cure these noted deficiencies in Gai and O'Toole.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ***rmccutcheon@munckcarter.com***.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

MUNCK CARTER, LLP

Date: 7/17/2009

Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@munckcarter.com*